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09/973,349	10/09/2001	Douglas Charles Pratt	2001P07594 US01	5262

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EXAMINER

HAMILTON, MONPLAISIR G

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 06/07/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/973,349

Applicant(s)

PRATT, DOUGLAS CHARLES

Examiner

Monplaisir G Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The communication filed on 3/18/04 amended Claims 1, 5-7, 9, 15-17 and 19. Claims 1-20 remain for examination.

#### ***Response to Arguments***

2. Applicant's arguments, see Paper No. 4, filed 3/18/04, with respect to the rejections of Claims 1, 2, 4, 7, 10 and 12-20 under 35 U.S.C. § 102(e) as being anticipated by Call1 (US 6,418,441) and Claims 3 and 11 under 35 U.S.C. § 103(a) as unpatentable over Call1 (US 6,418,441) in view of Call2 (US 20020161745) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Johnson et al (US 6,055,516).

Applicant's argue: "Johnson alone or Call1 does NOT suggest "prioritized search" of an identifier code database mapping said first identifier code to a corresponding second identifier code identifying said object". Instead, Johnson discloses a prioritized search of product information in a database of information on different products and returns the "matching product information" NOT a corresponding second identifying said object." (Arguments, Section IV: page 16-17).

Examiner disagrees with applicant. Johnson specifically discloses that his search is able to identify part numbers corresponding to same item. Specifically, Johnson states, host computer

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10 would recognize the entry item fore the item from Vendor Promega's Catalog (R6012, 00005860) as corresponding to that same item available from Fisher's Catalog (PRR6012, 00000001) (col 10, lines 45-55) . Examiner maintains that Johnson system efficiently maps identifiers to corresponding identifiers for the same item (col 14, lines 40-50). Accordingly a new grounds of rejection in view of Johnson is detailed below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5-10 and 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al (US 6,055,516).

Referring to Claims 1, 15-17:

Johnson discloses a method for determining a specific identifier code for an object associated with a plurality of identifier codes by a corresponding plurality of entities, comprising the steps of:

receiving a first message including at least a first identifier code identifying an object, said first identifier code being associated with a first entity (col 8, lines 1-15);

extracting said first identifier code from said received first message (col 10, lines 1-10);

generating a second message incorporating said extracted first identifier code, second message being for initiating a search of an identifier code database mapping said first identifier code associated with a first entity to a corresponding second identifier code identifying said object, said second identifier code being associated with a second entity different to said first entity (col 10, lines 45-55);

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receiving said second identifier code corresponding to said first identifier code in response to communicating said second message for initiating a search of said identifier code database (col 10, lines 45-50; col 14, lines 40-55).

Referring to Claim 2:

Johnson discloses the limitations of Claim 1 above. Johnson further discloses said second message initiates a remote procedure for mapping said first identifier code to a corresponding second identifier code (col 5, lines 25-35).

Referring to Claim 4:

Johnson discloses the limitations of Claim 1 above. Johnson further discloses communicating said second message to an application useable for initiating a search of said identifier code database (col 4, lines 5-15).

Referring to Claim 5:

Johnson discloses the limitations of Claim 1 above. Johnson further discloses said second message initiates a prioritized search of said database and an object comprises at least one of, (a) an article of manufacture, (b) a service and (c) a non-manufactured item and an entity comprises at least one of, (a) an object retailer, (b) an object wholesaler, (c) an object distributor, (d) an object manufacturer, (e) an object servicing enterprise and (f) an object seller (col 10, lines 20-35).

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Referring to Claim 6:

Johnson discloses the limitations of Claim 5 above. Johnson further discloses said prioritized search of said database searches first for a purchaser product identifier code identifying said object and subsequently for a manufacturer product identifier code identifying said object (col 6, lines 19-25).

Referring to Claim 7:

Johnson discloses the limitations of Claim 1 above. Johnson further discloses said extracting step comprises extracting said first identifier code and a corresponding third identifier code identifying said object from said received first message, and said generating step generates a second message incorporating said extracted first and third identifier codes (col 6, lines 5-10).

Referring to Claim 8:

Johnson discloses the limitations of Claim 7 above. Johnson further discloses said first identifier code comprises a purchaser product identifier code and said third identifier code comprises a manufacturer product identifier code and said second message initiates a prioritized search of said database involving searching first for said purchaser product identifier code and subsequently for a manufacturer product identifier code (col 6, lines 5-25).

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Referring to Claim 9:

Johnson discloses the limitations of Claim 1 above. Johnson further discloses said second message incorporates rules determining conduct of said search of said identifier code database (col 6, lines 20-30).

Referring to Claim 10:

Johnson discloses the limitations as discussed in Claim 9 above. Johnson further discloses said rules are predetermined in an application used for accessing said database (col 4, lines 5-15; col 6, lines 20-30).

Referring to Claim 12:

Johnson discloses the limitations as discussed in Claim 1 above. Johnson further discloses an identifier code mapping application (col 10, lines 40-55) and said identifier code mapping application and said database are co-located on the same processor (col 9, lines 5-20), said processor comprising one, of (a) a server, (b) a PC (c) a wireless device, (d) a mainframe computer and (e) another networked processing device (col 4, lines 5-50).

Referring to Claim 13:

Johnson discloses the limitations as discussed in Claim 1 above. Johnson further discloses at least one of said first and said second identifier codes comprise one of (a) a Universal Product Code and (b) a code associated with a bar code (col 4, lines 40-50).



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Referring to Claim 14:

Johnson discloses the limitations as discussed in Claim 1 above. Johnson further discloses a method for supporting a transaction in accordance with claim 1, wherein

said first message is received from an application initiating a transaction and including the steps of (col 3, lines 5-25);

forwarding a composite message to a destination application in support of said transaction, said composite message being created including information derived from said first message and including said second identifier code (col 12, lines 50-65; col 14, lines 30-50; col 15, lines 20-35).

Referring to Claim 18:

Johnson discloses the limitations of Claim 17 above. Johnson further discloses generating a record of said search and provision of said second identifier code for use in at least one of (a) billing, and (b) creating a transaction record (col 14, lines 30-50; col 15, lines 20-35).

Referring to Claim 19:

Johnson discloses a system for providing a specific identifier code for an object associated with a plurality of identifier codes, comprising:

a communication processor for bi-directionally communicating with remote applications (col 3, lines 55-65);

an identifier code database (col 4, lines 40-45);

a first application for,

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initiating a search of said database to translate a first identifier code identifying an object associated with a first entity to a corresponding second identifier code identifying said object., said second identifier being associated with a second entity different to said first entity in response to receiving a message including a plurality of corresponding identifier codes identifying said object and provided by remote applications (col 4, lines 5-15; 40-65; col 9, line 55-col 10, line 40), and for

augmenting said database by updating said database to incorporate additional corresponding codes from said received plurality of corresponding identifier codes identifying said object (col 9, lines 55-65); and

providing said second identifier code corresponding to said first identifier code in response to said initiated search of said identifier code database via said communication processor (col 10, lines 20-55; col 14, lines 40-50).

Referring to Claim 20:

Johnson discloses the limitations of Claim 19 above. Johnson further discloses an object comprises at least one of, (a) an article of manufacture, (b) a service and (c) a non-manufactured item and an entity comprises at least one of, (a) an object retailer, (b) an object wholesaler, (c) an object distributor, (d) an object manufacturer, (e) an object servicing enterprise and (f) an object seller (col 10, lines 20-35).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US 6,055,516) in view of Tenorio (US 6708161).

Referring to Claim 3:

Johnson discloses the limitations as discussed in Claim 2 above.

Johnson does not explicitly disclose "said second message uses Simple Object Access Protocol (SOAP) for invoking said remote procedure".

Tenorio discloses said second message uses Simple Object Access Protocol (SOAP) for invoking said remote procedure (col 10, lines 45-65).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Johnson such that the second message uses SOAP. One of ordinary skill in the art would have been motivated to do this because it would allow the system to request provide e-commerce communication (Tenorio col 10, lines 45-50).

Referring to Claim 11:

Johnson discloses the limitations as discussed in Claim 1 above.

Johnson does not explicitly disclose “communicating said second message to an application for accessing said database using at least two of, (a) Hypertext Transfer Protocol (HTTP), (b) Simple Object Access Protocol (SOAP) and (c) XML (Extensible Markup language)”

Tenorio disclose communicating said second message to an application for accessing said database using at least two of, (a) Hypertext Transfer Protocol (HTTP), (b) Simple Object Access Protocol (SOAP) and (c) XML (Extensible Markup language) (col 10, lines 45-65).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Johnson such that the second message uses SOAP. One of ordinary skill in the art would have been motivated to do this because it would allow the system to request provide e-commerce communication (Tenorio col 10, lines 45-50).

### ***Final Rejection***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monplaisir G Hamilton whose telephone number is (703) 305-5116. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monplaisir Hamilton

  
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